

REMARKS

[0002] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 25-27, 30, and 57 were pending
- Claims 3, 4, 9, 11, 14, 17, 20, 28-29, 33-34, 39, 41, 43-44, 47, and 50, were previously canceled
- Claims 1-2, 5-8, 10, 12-13, 15-16, 18-19, 21-24, 31-32, 35-38, 40, 42, 45-46, 48-49, and 51-59 were previously withdrawn
- Claims 25-27, 30, and 57 are amended herein
- New claims 60-63 are added herein
- Claims 25-27, 30, 57, and 60-63 are currently pending

[0003] Support for the amendments to the claims is found at least on page 22 of the application as originally filed. Support for the new claims is found in claims 25-27, 30, and 57 as well as the application as originally filed. No new matter has been added.

Claims 25-27 and 30 Recite Statutory Subject Matter Under § 101

[0004] Claims 25-27 and 30 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

[0005] Nevertheless, for the sole purpose of expediting prosecution and without commenting on the propriety of the Office's rejections, Applicant herein amends claims

25-27 and 30 as shown above to replace "architecture" with "system". Applicant respectfully submits that this amendment renders the §101 rejection moot.

Claim 27 Complies With § 112 1st Paragraph

[0006] Claim 27 stands rejected under 35 U.S.C. §112, ¶ 1, as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

[0007] Nevertheless, for the sole purpose of expediting prosecution and without commenting on the propriety of the Office's rejections, Applicant herein amends claim 27 as shown above to remove recitation of "rev = tag". Applicant respectfully submits that these amendments render the §112, ¶ 1 rejection moot.

Cited Documents

[0008] The following documents have been applied to reject one or more claims of the Application:

- Marconcini: Marconcini, et al., U.S. Patent No. 6,834,110
- Cocotis: Cocotis, et al., U.S. Patent Application Publication No. 2002/0112162
- Sudia: Sudia, et al., U.S. Patent No. 6,209,091
- Wall: Wall, et al., U.S. Patent Application Publication No. 2002/0120939
- Alleged "Applicant Admitted Prior Art" (AAPA): Heredia, Edwin, U.S. Patent Application Publication No. 2004/0068757

The Office Has Failed to Set Forth a *Prima Facie* Case of Obviousness of Claims 25, 30, and 57

[0009] Claims 25, 30, and 57 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Marconcini, Coctis, and Sudia in view of "AAPA." Applicant respectfully traverses the rejection.

[0010] Initially, Applicant notes that the Office characterizes Applicant's own application as applicant admitted prior art (AAPA). (Office Action, pages 3-4). Applicant respectfully disagrees with this characterization.

A statement by an applicant >in the specification or made< during prosecution identifying the work of another as "prior art" is an admission **>which can be relied upon for both anticipation and obviousness determinations, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003); *Constant v. Advanced Micro-Devices Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1063 (Fed. Cir. 1988).< However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.").

MPEP §2129 (I) emphasis added

[0011] The record is devoid of any Applicant admissions of prior art. Applicant's application is devoid of any identification of the work of another as prior art; the phrase "prior art" is not found in Applicant's application. Even statements in a "Background" section of a patent application are not *per se* AAPA absent a statement by the Applicant

identifying **work of another** as "prior art." Accordingly, the record contains nothing properly characterized as "AAPA."

Independent Claim 25

[0012] Applicant submits that the Office has not made a *prima facie* showing that independent claim 25 is obvious in view of the combination of Marconcini, Coctis, and Sudia. The Office relies on Applicant's own disclosure to teach the feature of "*the application is a supplemental television application delivered through an interconnecting channel separate from a channel used to deliver broadcast media.*" Accordingly, the Office implicitly admits that the combination of Marconcini, Coctis, and Sudia fails to disclose, teach, or suggest this feature of Applicant's claim 25. Applicant explains above why Applicant's application is **not** a valid reference for use in rejecting claims of that same application. Accordingly, Applicant submits that the valid references of record do not teach or suggest, alone or in combination, each and every feature of this claim.

[0013] Moreover, claim 25 recites in part, "*a start file including a link to the security information resource file or the security information file, wherein the start file carries application run parameters and references an application boot file to start execution of the application.*" The Office cites Marconcini, column 83, lines 28-52 and column 88, lines 30-40) as **inherently** teaching this element. (Office Action, page 4.) Rather, Marconcini describes a Helper Application and application programming interfaces (APIs). (Marconcini, column 83, lines 34-35; column 88, lines 31-35). Applicant agrees with the Office that none of the valid references of record expressly disclose, teach, or suggest this feature of Applicant's claim 25.

[0014] The Office looks to the body of Applicant's disclosure to support a conclusion that Marconcini inherently teaches "*a start file including a link to the security information resource file or the security information file, wherein the start file carries application run parameters and references an application boot file to start execution of the application,*" as recited in Applicant's claim 25. (Office Action, page 4). Applicant respectfully submits that the Office's characterization of a start file in Marconcini as being inherent with respect to claim 25 is improper.

[0015] According to MPEP §2112(IV), the Office always bears the initial burden of developing reasons supporting a reliance on inherency. To satisfy this burden, the Office must identify some basis in fact or articulate some reasoning at least tending to show that allegedly inherent subject matter necessarily (i.e., inevitably) flows from cited art. Indeed, MPEP §2112(IV) states, in part, that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." It necessarily follows that the identifying the certain result or characteristic in Applicant's own disclosure is also not sufficient to establish the inherency of that result or characteristic. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)" (Id.) "**In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably**

support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.' *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)" (Id.) (emphasis added).

[0016] Applicant respectfully points out that the Applicant's application is the only objectively verifiable document of record that shows or suggests what the Office purports the references of record to teach. Based on the explicit reliance on Applicant's application to supply a grounds of rejection for claim 25, Applicant concludes that the Office is interpreting the valid references of record through the lens of Applicant's application, which is impermissible hindsight use. (See MPEP §2142). Thus, for all the above reasons, the Office has failed to set forth a *prima facia* case that Applicant's claim 25 is unpatentable in light of the valid references of record.

[0017] Given that "[p]rior art rejections should ordinarily be confined **strictly** to the best available art" and the Office has indicated that teachings from Applicant's application are necessary to sustain a rejection of the currently pending claims (thus, acknowledging that there is no better available art), Applicant respectfully requests withdrawal of the rejection of this claim and prompt issuance of a notice of allowance (MPEP §706.02, I. CHOICE OF PRIOR ART; BEST AVAILABLE; emphasis added).

Dependent Claims 30 and 57

[0018] Claims 30 and 57 ultimately depend from independent claim 25. As discussed above, claim 25 is patentable over the valid references of record. Therefore, claims 30 and 57 are also patentable over the valid references of record for at least their dependency from a patentable base claim. These claims may also be patentable for the additional features that each recites.

**The Office Has Failed to Set Forth a *Prima Facie* Case of Obviousness of
Claim 26**

[0019] Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Marconcini, Coctis and Sudia, in view of "AAPA" and further in view of Wall. Applicant respectfully traverses the rejection.

Dependent Claim 26

[0020] Claim 26 ultimately depends from independent claim 25. As discussed above, claim 25 is patentable over the valid references of record. Wall is directed to creating and transmitting webcast programs. (Wall, paragraph 0004). Wall does not compensate for the deficiencies identified above with respect to the other valid references of record. Therefore, dependent claim 26 is also patentable over the valid references of record for at least its dependency on a patentable base claim. Additionally, this claim may also be patentable for the additional features that it recites.

New Claims 60-63

[0021] Applicant adds new claims 60-63 to further clarify features of the claimed subject matter. Based on the above discussion regarding claim 25, Applicant believes that claims 60-63 are also patentable for at least the same reasons. Applicant respectfully submits that the valid references of record do not support a *prima facie* case of unpatentability of these claims.

Conclusion

[0022] For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If the next communication from the Office will be anything other than a Notice of Allowance, Applicant requests that the Examiner contact the undersigned representative.

Respectfully Submitted,

Lee & Hayes, PLLC
Representative for Applicant

/Benjamin Keim 59,217/

Dated: November 12, 2009

Benjamin A. Keim
(benjamink@leehayes.com; 509-944-4748)
Registration No. 59217

Reviewer/Supervisor: Shirley L. Anderson (shirley@leehayes.com; 509-944-4758)
Registration No. 57763